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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,700	04/19/1999	NORIKO MIZOBUCHI	20-4518P	1380
2292	7590	06/14/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER

1616

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/242,700
Filing Date: April 19, 1999
Appellant(s): MIZOBUCHI ET AL.

Marc S. Weiner
For Appellant

Date mailed
6-14-04

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 14, 16, and 23-25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 14, 16, and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Firstly, the newly amended claim to recite the weight percent of 20% to 30% and 25% to 30% does not find support in the instant specification. Secondly, the new recitation wherein the weight percent is 20% to 30% in a hydrocarbon gel or mixture of hydrocarbon and petrolatum base and 25% to 30% in a petrolatum base does not find support in the instant specification. The specification supports the range of 0.001 to 30, preferably 0.01-20%, and most preferably 0.05-15%. See page 3 of instant specification. However, nowhere in the specification is there support of 20-30% and 25-30% based upon the base. Applicant does not have support for the instant range nor does applicant have support for a certain weight percentage based on the carrier (base) utilized. Accordingly, the claims are rejected under new matter.

(11) Response to Argument

The applicant argues that there is sufficient implicit support for the range of 25-30% by combining the disclosed range of 0.001-30% disclosed on page 3 and the lower limit of 25% found in example 6.

Firstly, the examiner points out to page 3, lines 15-16 of the instant specification wherein applicant states that aspirin is contained in an ointment in the amount of "0.001 to 30% by weight, preferably 0.01 to 20% by weight, more preferably 0.05 to 15% by weight". From this disclosure, it is quite clear that applicant's preferable range is 0.01 to 20% or 0.05 to 15% by weight. However, after the examiner applied both anticipatory and obviousness art rejections based on an aspirin concentration of 0.01 to 20% and 0.05-15%, the applicant has attempted to carve around the prior art by reciting the instant weight of 25 to 30%. This range is clearly not supported by the specification. Moreover, the example of line 5, on page 6 of the instant specification utilizes a maximum weight percentage of 25% aspirin. Example 1 utilizes a weight percent of 0.5, example 2 utilizes a weight percent of 8, example 3 utilizes a weight percent of 5, example 4 utilizes a weight percent of 25, example 5 utilizes a weight percent of 0.5, and example 6 utilizes a weight percent of 1. Thus, clearly demonstrating that 25% is the upper limit of the aspirin concentration and not the argued lower limit of the aspirin seen in the unsupported range of 25 to 30%.

Therefore, it is respectfully submitted that the applicant cannot pick and choose a range within a range that was not clearly envisioned at the time the invention was filed based solely on the fact that it is not encompassed by the prior art either through anticipation or obviousness.

The applicant argues that page 3 of the instant specification states that the acetyl salicylic acid should be used in a range of 0.001-30% in hydrocarbon gel and/or petrolatum. Therefore, applicant states there is sufficient support to recite that a range of 25 to 30% in a petrolatum base.

The examiner notes that on page 3 of the instant specification that applicant states that the base of the preparation may be hydrocarbon gel and/or petrolatum. Further, it is noted that page 3 discloses that the amount of aspirin an ointment is in the amount of "0.001 to 30% by weight, preferably 0.01 to 20% by weight, more preferably 0.05 to 15% by weight". However, these two statements are not in conjunction with each nor do they appear in the same paragraph of each other on page 3. Nowhere in the specification does the applicant state that the criticality of the concentration of the acetyl salicylic acid is in accordance to the base nor does the applicant even vaguely link the concentration of the aspirin with the type of base utilized. In actuality the examples teach away from applicant's recitation of 25-30% aspirin in petrolatum base. The examiner points to page 6, lines 5 to 8, the only example that utilizes 25% aspirin wherein the base is a *hydrocarbon gel* and not the recited petrolatum base.

Accordingly, it is respectfully submitted applicant has analyzed the prior art rejections and has carved around the prior art with amendments that were not clearly envisioned at the time the application was filed to obtain a patent.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Sharmila S. Gollamudi



June 7, 2004

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